

Remarks

Reconsideration and allowance of this application are respectfully requested in light of the foregoing amendments and the following remarks.

Attached hereto please find a substitute Declaration, which is in compliance with 37 CFR 1.67(a).

Applicant wishes to thank the Examiner for reconsidering and removing the restriction requirement.

With regard to the 112, second paragraph rejection, please note that Claims 5 and 9 have been amended as requested at Paragraph 4 of Paper No. 5. Accordingly, this rejection must be removed.

With regard to the anticipation rejection against Claims 1-4, 6-8, 10, and 11 in view of EP 603500, please note that the claims now distinguish that reference. Specifically, EP 603500 is directed to a battery separator made from a microporous ultra-high molecular weight polyethylene (UHMWPE) membrane. Independent Claims 1 and 2 have been amended to exclude UHMWPE. Support for the amendments is found in the application at page 5, lines 16-18. Accordingly, the anticipation rejection must be removed.

Claims 5 is rejected as being unpatentable over EP 603500 in view of Lundquist et al (U.S. Patent 4,650,730). Applicant respectfully traverses this rejection in view of the amendments made to Claims 1 and 2 that distinguish EP 603500. Accordingly, this rejection must be removed.

Claim 9 is rejected as being unpatentable over JP 8-20659. Applicant respectfully traverses this rejection.

In essence, the Examiner has taken the position that in view of the apparent similarity between the claimed invention and JP 8-20659 (the amount of wax causing the rub), that patentability for the invention is not possible unless there is a showing of unexpected result. Applicant has made such a showing, explained below. Accordingly, this rejection is in error. MPEP 2144.05, III (below the citation to *In re Woodruff*).


The instant invention teaches that pore formation is not hindered when wax in excess of 15% is used. Referring to the examples in the instant application, please note that most of the inventive formulations require at least 20 percent wax and have Gurleys that are less than half those JP 8-20659 (the Gurley value are set out in Working example 1, Paragraph 62, and prophetic ranges in Paragraph 44).

JP 8-20659 does not teach or suggest that pore formation is not hindered when wax in excess of 15% is used. To the contrary, JP 8-20659 teaches, in paragraph 40 at page 10, that when the wax content is excessively high (greater than 13% $(15/(115) \times 100\%)$) pore formation is impaired. The definition of excessively high is inferred from paragraph 40. There, the inventors disclose the maximum wax limit as being 15 parts by weight or 13% by weight, and that the most ideal weight range is about 10 parts or about 9% by weight. Additional confirmation of this definition is found in the working examples set forth in Paragraphs 62 and 63 of the reference. In Working Example 1, when a film was made with a 5% by weight wax, it obtained a Gurley of 43 seconds per 10 cc. In Working Example 2, a 7 percent wax formulation was made, but no Gurley value was reported. (Query, was the Gurley value left out because it was greater than 43 seconds, this is a likely conclusion in view of the information set forth in paragraph 40.)

In comparison, the instant invention obtains an unexpected result -- good Gurley values at wax levels above 15%. Accordingly, the instant invention that claims wax values greater than 15% is not suggested by the prior art. Accordingly, the rejection is in error.

An early Notice of Allowance is respectfully requested in the instant application.

Respectfully submitted,



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